



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,993	04/13/2004	Douglas B. Macrac	IS-105 Cont.	5005

1473 7590 10/22/2007
ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

GRAHAM, PAUL J

ART UNIT	PAPER NUMBER
----------	--------------

2623

MAIL DATE	DELIVERY MODE
-----------	---------------

10/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/823,993	MACRAE ET AL.	
	Examiner	Art Unit	
	Paul J. Graham	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/16/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/16/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The references listed on the Information Disclosure statement filed 2/16/2006 have been considered by examiner (see attached PTO-1449).

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is unclear (from the title) how the instant application is distinguishable from US Patent #: 6745391 B1. Appropriate correction is required.
3. The disclosure is objected to because of the following informalities: On page 26, line 14 of the specification, "...**broadcase** transmitter." should read "...**broadcast** transmitter." Appropriate correction is required.

Obviousness Type Double Patenting Rejection

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2623

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/752,739. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim limits of a "user interface" and "client-side device" are expressly restated in the copending application No. 10/752,739 and the claim limitation of a server coupled to the data network is implied in the instant application. See below.

Claim 1/3 of US Pat #: 6745391 B1	Claim 1 of Instant App#: 10/823,993
<p>1. <i>A television schedule system comprising:</i></p> <p><i>a display displaying program listings for a plurality of television channels in a guide format;</i></p> <p><i>a processor coupled to the display, the processor configured to receive data indicating that a regularly scrambled television channel is to be unscrambled for a promotional time period and in response, configured to determine whether the regularly scrambled television channel is subscribed to by the user, and only if the regularly scrambled television channel is not subscribed to by the user, the processor being configured to insert into the display during or prior to the promotional period a promotional message indicating that the regularly scrambled television channel is unscrambled.</i></p> <p>3. <u>The television schedule system of claim 1 further comprising an electronic program guide memory storing program listings, wherein the processor updates the electronics guide memory with a program listing associated with a regularly scrambled television channel not subscribed to by the user in response to the receipt of data indicating that the regularly scrambled television channel not subscribed to by the user is to be unscrambled.</u></p>	<p><i>A television schedule system configured with an <u>electronic program guide (EPG) database</u>, the system comprising:</i></p> <p><i>a receiving location for receiving a plurality of regularly scrambled television channels and a plurality of regularly unscrambled television channels;</i></p> <p><i>and a processor for <u>maintaining the EPG database with program listings for a plurality of the regularly unscrambled television channels</u>, the processor further <u>updating the EPG database for a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels</u>.</i></p>

Note the comparison above; claim 1 of the instant application is not patentably distinct from claim 1 of US Patent # 6745391 B1.

Art Unit: 2623

For example, claim 1 of the instant application, is broader than claim 1 of US Patent # 6745391 B1 because it recites the limitation "a processor for maintaining the EPG ..." and "...updating ...without scrambling on one of the regularly scrambled television channel.". However, those recited limitations in the instant application are found in dependent (upon claim 1) claim 3 of US Patent # 6745391 B1 (see underlined emphasis). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have narrowed claim 1 of the instant application to only recite "a television scheduling system", "a receiving location" (i.e., the processor or display), and "a processor".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lett et al. (US 5 592 551)

As to claim 1, Lett discloses a television schedule system configured with an electronic program guide (EPG) database, the system comprising (see Lett, fig. 1 and col. 4, ll. 10-20 for schedule system; col. 5, ll. 40-47 for EPG database):

a receiving location for receiving a plurality of regularly scrambled television channels and a plurality of regularly unscrambled television channels (see Lett, fig. 1 for receiving location 12 and

Art Unit: 2623

14, fig. 4B for listing of scrambled/unscrambled channels (e.g., WXIA-14 = unscrambled, HBO-15=scrambled); and a processor (secure micro in Lett, fig. 3) for maintaining the EPG database with program listings for a plurality of the regularly unscrambled television channels (see Lett, col. 6, ll. 18-25), the processor further updating the EPG database for a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels (see Lett, col. 14, ll. 55-60, where a free preview (for whatever time period) must be an unscrambled version of a regularly scrambled program and col. 10, ll. 55-60 for processor updating database).

7. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Youman et al. (5629733).

As to claim 1, Youman discloses a television schedule system configured with an electronic program guide (EPG) database, the system comprising (see Youman, col. 1, ll. 7-11, col. 7, ll.51-55 for EPG info and col. 8, ll. 18-21 for database and note title of patent):

a receiving location for receiving a plurality of regularly scrambled television channels and a plurality of regularly unscrambled television channels (see Youman, col. 8, ll. 18-21 for location, fig. 8 for regularly unscrambled channels and fig. 10 for regularly scrambled channels); and a processor (microcontroller in fig. 1) for maintaining the EPG database with program listings for a plurality of the regularly unscrambled television channels (see Youman, col. 8, ll.18-25; col. 9, ll. 8-17), the processor further updating the EPG database for a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels (see fig. 28, where database is updated for promo channel—HBO channel unscrambled for weekend and EPG shows that information; and see col. 27, ll. 42-54 where processor updates the db when user subscribes to a regularly scrambled channel—there is a message confirming user request, see fig. 9 for promo, which would not be displayed once the user has subscribed to that channel; therefore an update to the db is necessary to update such information as obtained through the EPG an no longer display the subscription message any longer).

As to claim 2, Youman discloses the system of claim 1, wherein updating the EPG database includes turning on one of the regularly scrambled television channels which is now unscrambled (see Youman col. 8, ll. 21-24), for displaying program listings of the program transmitted on the now unscrambled channel (see Youman, fig. 10 with channels for premium service).

As to claim 3, Youman discloses the system of claim 1, wherein updating the EPG database includes adding the program listing of the program transmitted without scrambling into the database (see Youman, col. 8, ll. 21-24 on updating the listings and fig. 10 showing premium channel schedules).

As to claim 4, Youman discloses the system of claim 1, further comprising a detector coupled to the processor for detecting whether one of the regularly scrambled television channels is now unscrambled (see Youman, fig. 28A, where the message "Free HBO Preview Tonight" is displayed; here the system detected a new channel is going to be available therefore a detection mechanism must be coupled to the processor).

As to claim 5, Youman discloses the system of claim 4, wherein the processor updates the EPG database based on the output of the detector (see Youman, col. 8, ll. 21-24 and col. 27, ll.42-54).

As to claim 6, Youman discloses the system of claim 1, wherein the processor receives data from a service provider indicating the periods during which one of the regularly scrambled television channels will be unscrambled (see Youman, fig. 28 and 28A, where the figs. Tell that HBO will become available "tonight" or "this weekend"; therefore, the database received the info from the service provider noting that HBO would be unscrambled for this time period).

As to claim 7, Youman discloses the system of claim 1 further comprising a display for displaying a portion of the EPG database in a guide format (see Youman, figs. 6, 8, 18, 19, 20, 25 for example displays).

Art Unit: 2623

As to claim 8, Youman discloses the system of claim 7, wherein the display further displays a promotional message in the guide for informing a viewer that one of the regularly scrambled television channels is now unscrambled (see Youman, fig. 28A where "Free HBO tonight" is a promotional message of a regularly scrambled channel).

As to claim 9, Youman discloses the system of claim 8, wherein the promotional message is visually distinguished from the program listings of programs transmitted on one or more of the regularly unscrambled television channels (see Youman, fig. 28 – where the message is in BIG letters and separated from other info on the display).

As to claim 10, Youman discloses the system of claim 8, wherein the portion of the EPG database including a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels is displayed upon user selection of the promotional message (see Youman, fig. 28A where user clicks on the promotional message: "Free HBO Preview Tonight" and figs. 9, 10, and 18 show the listing for scrambled channels).

As to claim 11, Youman discloses the system of claim 1, wherein the processor further adds one of the regularly scrambled television channels into a list of displayed channels (see Youman, figs. 9, 10, 18 show the listings for regularly scrambled channels).

As to claim 12, Youman discloses the system of claim 1, wherein the processor further transmits an order to subscribe the television system with a service provider of one of the regularly scrambled television channels (see Youman, fig. 26 requesting subscription to a movie or special event or family programming; and fig. 9 to order the HBO channel; fig. 10; fig. 23-24a shows the process of subscribing to a channel to watch a movie).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski et al. (US 5 734 589) in view of Lett et al. (US 5 592 551)

As to claim 1, Kostreski discloses a television schedule system configured with an electronic program guide (EPG) database, the system comprising (see Kostreski, fig. 3 and 5 for schedule system; col. 5, ll. 60-67 for EPG database):

a receiving location for receiving a plurality of regularly scrambled television channels and a plurality of regularly unscrambled television channels (see Kostreski, fig. 3 for receiving location, fig. 5 for listing of scrambled/unscrambled channels (e.g., NBC-4 = unscrambled, Star Wars-12=scrambled); and a processor (microprocessor in Kostreski, fig. 1) for maintaining the EPG database with program listings for a plurality of the regularly unscrambled television channels (see Kostreski, col. 4, ll. 20-44),

Kostreski does not teach an unscrambled program transmitted on a regularly scrambled channel, however, Lett, who discloses an interactive EPG, does teach this.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the schedule system of Kostreski with the EPG of Lett to augment the viewing options of end users to include previewing a PPV event for a period of time (see Lett, col. 14, ll. 55-61).

Art Unit: 2623

the processor further updating the EPG database for a program listing of a program transmitted without scrambling on one of the regularly scrambled television channels (see Lett, col. 14, ll. 55-60, where a free preview (for whatever time period) must be an unscrambled version of a regularly scrambled program and col. 10, ll. 55-60 for processor updating database).

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J. Graham whose telephone number is 571-270-1705. The examiner can normally be reached on Monday-Friday 8:00a-5:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pjg
10/10/2007



VIVEK SRIVASTAVA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

